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In re Application of:

Thomas O.P. Fletcher et al.

Group Art Unit: 2172

Serial No. 09/824,252

Examiner: Jean M. Corrielus

Filed: April 3, 2001

Atty. Docket No.: 59119-00002

For: IMPROVED METHOD AND SYSTEM OF COMPUTER FILE MANAGEMENT

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

September 9, 2004

Sir:

The Office Action dated August 9, 2004, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

The Office Action of August 9, 2004, was a restriction requirement, requiring election between one of the following three inventions, which were claimed in the application. The three alleged inventions are:

Invention I, recited in claims 1-2, drawn to a computer system for accessing files in a main file system;

Invention II, recited in claims 3-13 and 15-28, drawn to a method for preparing a custom file system for computer system; and

Invention III, recited in claim 14, drawn to a method for managing a file system.

Applicants respectfully elect to prosecute the subject matter of Invention II, recited in claims 3-13 and 15-28, drawn to a method for preparing a custom file system for computer system, with traverse. Applicants therefore respectfully request timely consideration on the merits. The Office Action took the position that the listed inventions can be classified in different subclasses, 1, 101 and 202, of class 707. Applicants submit the restriction requirement is improper, and should be withdrawn in view of the following remarks.

As noted in MPEP 802.1, 35 U.S.C. §121 states that the Office may require restriction if two or more “independent and distinct” inventions are claimed in one application. Thus, the restriction requirement is not proper if it can be shown that two groups of claims are not independent from one another, or are not distinct from one another.

As defined in MPEP 802.1, the term “independent,” or not dependent, is defined as meaning “that there is no disclosed relationship between the two or more subjects disclosed, that is, they are **unconnected in design, operation or effect . . .**” (emphasis added) According to MPEP 802.1, the term “distinct” is defined as meaning “that two or more subjects as disclosed are related, for example, as combination and part . . . and **are patentable (novel and unobvious) over each other . . .**” (emphasis added)

Applicants submit that the Office Action's restriction requirement is improper because the restriction does not satisfy either of the two necessary conditions, independence and distinctness. Referring to independent claims 1, 3 and 14, which appear in groups I, II and III, respectively, applicants submit that the subject matter recited in the claims are not unconnected in design, operation and effect. Each of the claims recites providing a "custom filesystem," which is done by a system including a "main filesystem," a "computer system," "system attributes" and "links." The custom filesystem, recited in each independent claim, is positioned to take "priority" over the main filesystem. As noted above, these features are recited in independent claims 1, 3, and 14. Applicants submit that the claims cannot be considered "unconnected in design, operation, or effect" when the claims all share the same, major limitations.

With regard to groupings I, II and III allegedly being distinct, applicants submit that the Office did not provide any evidence of a basis for the claims to be "patentable . . . over each other." In fact, in the Office Action dated November 7, 2003, the Office rejected all of the claims as allegedly obvious in view of the same prior art reference- United States Patent No. 6,356,915 (Chtchekine et al.). Applicants submit that if the claims were "patentable . . . over each other," then the Office would have had to rely on more than one common reference to reject the claims in the Office Action dated November 7, 2003. Applicants further submit that the Office has estopped itself from raising the restriction requirement at this point in

prosecution because of the previous rejection of the independent claims of each group being unpatentable on the same grounds.

Applicants have claimed the subject matter of the same invention from different perspectives in an attempt to capture the full breadth of the present invention. Applicants are entitled to this breadth because, as noted above, each of the independent claims recite the same limitations, and are not independent and distinct. Thus, the restriction requirement is improper, and applicants respectfully request that the restriction requirement be withdrawn.

The Office also alleged that the groupings I, II and III fall into three different subclasses 1, 101 and 202, under the same class 707. As noted above, however, the application has already been examined on the merits, and a previous Office Action was issued on November 7, 2003. Further, the filing date of the present application is April 3, 2001. Applicants submit that the restriction requirement is improper because the present application has been pending for more than 3 years, and that examining the claims would not place an unreasonable burden on the Office.

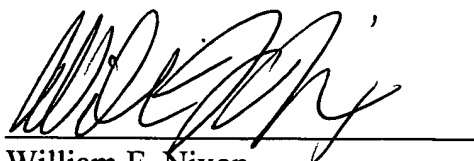
According to 37 C.F.R. 1.129(b)(1), “in an application, other than for reissue or design patent, that has been pending for at least three years . . . no requirement for restriction or for the filing of divisional applications shall be made or maintained in the application.” The restriction requirement was issued more than 3 years from the filing date of the application. Thus, applicants submit that the application has been pending for more than 3

years, and, that because of this pendency, the Office has failed to show that a serious burden would be placed on the Office in examining the application and the pending claims. In addition, the currently pending claims were amended in the Response filed May 17, 2004. No new independent claims, however, were added in the Response, and the amended claims were not so heavily amended so as to change the scope of the claims into independent and distinct inventions. Thus, the restriction requirement is improper and applicants respectfully request that the restriction requirement be withdrawn.

In summary, applicants elect, with traverse, the subject matter of Invention II. Applicants also request that the restriction requirement be withdrawn and that all of claims 1-28 be examined. Applicants reserve the right to file a divisional application on the non-elected claims at any point prior to the termination of the proceedings in the subject application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'W. F. Nixon', written over a horizontal line.

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